UNITED STATES PATENT AND TRADEMARK OFFICE

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AKC PATENTS
215 GROVE ST.
NEWTON, MA 02466

EXAMINER
HANNON, CHRISTIAN A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _03 April 2008_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-28_ is/are pending in the application.

    4a) Of the above claim(s) _16-28_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-15_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 1, 5 & 6 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites the limitation "the smart card reader" in the 8th line, starting at the

fourth word. There is insufficient antecedent basis for this limitation in the claim. The

applicant has introduced the term "smart card reader/writer" but has failed to define a

singular acting reader.

Claims 5 & 6 recite the limitation "said wireless mobile phone" in the 9th line and

3rd line respectively. There is insufficient antecedent basis for this limitation in the claim.

The claims prior merely introduce the term "wireless mobile device" yet fail to define the

device as a phone.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Benson (US 6,747,547) in view of Chung (US 7,036,730).

Regarding claim 1, Benson teaches a wireless mobile device adapted to access

a wireless network comprising a subscriber identification module (SIM) card slot and a

smart card reader writer module electrically connected to said wireless mobile device

via said SIM card slot (Column 3, Lines 35-45; Column 5, Lines 64-67; Column 6, Lines

3-6; Benson) and wherein said smart card reader writer module is adapted to receive

and read information stored in a smart card and to transmit said information to an entity

via said wireless network (Column 1, Lines 24-59; Benson), Benson teaches that

through a novel smart card reader writer module connected through an existing mobile

device's SIM slot information can be wirelessly exchanged to another network entity

(bank, network provider etc.) via said wireless network. However Benson fails to

explicitly teach that the smart card resides outside of the mobile device and outside of

the smart card reader without contacting said smart card. Chung teaches that

contactless smart cards are an option in conjunction with smart card readers and writers

that is contactless so that the smart card would reside outside of any device or reader,

so that it does not contact that reader or device (Column 10, Lines 58-67, Column 11,

Lines 1-6; Chung). Therefore it would be obvious to one of ordinary skill in the art to

take the teaching of Benson and attempt to implement the contact smart card reader

with that of a contactless smart card reader as taught by Chung as the outcome would

be predictable and well known in the art and furthermore would be motivated by a

desire to lessen actions required by an end user of physically inserting a smart card into

a reader.

Regarding claim 2, Benson and Chung teach claim 1 wherein said smart card

reader writer module is further adapted to receive information from said entity via said

network and transmit and write said information in said contactless smart card (Column

10, Lines 58-67, Column 11, Lines 1-6; Chung).

Regarding claim 3, Benson and Chung teach claim 1 wherein said information is

selected from a group consisting of cardholder identification information, card

identification information, authentication information, smart card issuer information,

financial institution information, digital goods, digital services and digital currency

(Column 1, Lines 39-49; Column 4, Lines 57-60; Benson).

Regarding claim 4, Benson and Chung teach claim 3, wherein said digital goods

are selected from a group consisting of electronic cash, electronic coupons, electronic

gift certificates electronic transit tokens, music, software, movies and books (Column 1,

Lines 39-49; Column 4, Lines 57-60; Benson). The examiner takes official notice that

use of electronic media is painfully well known in the art.

Regarding claim 5, Benson and Chung teach claim 1 further comprising a

memory (Figure 4, Item 16; Benson) a CPU (Figure 4, Item 10; Benson) a SIM card

connected to said SIM card slot (Figure 4, Item 19; Benson) said SIM card

authenticating said wireless mobile device to said wireless network(Column 1, Liens 50-

53; Benson) and a first application program (Figure 4, Item 11; Column 6, Lines 3-6;

Benson) associated with said memory and said CPU and being adapted to receive and

transmit instructions from said smart card reader writer module to said wireless mobile phone and the reverse (Column 2, Lines 56-61; Column 6, Lines 1-19; Benson).

Regarding claim 6, Benson and Chung teach claim 5 further comprising a second application program associated with said memory and said CPU and being adapted to route and transmit data and information among said wireless mobile phone, said smart card reader/writer module, and other interfaces connected to said CPU (Figure 4, Item 14; Column 6, Lines 7-10; Benson).

Regarding claim 7, Benson and Chung teach claim 6, wherein said other interfaces are selected from a group consisting of smart card interfaces, infrared transceiver interfaces, serial communication interfaces, and magnetic stripe reader interfaces (Column 3, Lines 39-41; Benson).

Regarding claim 8, Benson and Chung teach claim 6, wherein said first and second application programs are stored in storage selected from a group consisting of said CPU, said SIM card, an external SIM card, said smart card and an external card (Column 1, Lines 1-38; Benson).

Regarding claim 9, Benson and Chung teach claim 1 wherein said smart card reader writer module further comprises an antenna for receiving and transmitting messages to and from said smart card without contacting said smart card (Column 10, Lines 58-67, Column 11, Lines 1-6; Chung).

Regarding claim 10, Benson and Chung teach claim 1, wherein said wireless mobile device is selected from a group consisting of a mobile phone a personal digital assistant, a pager, a wireless laptop computer, a personal computer a television remote

control and combinations thereof (Column 1, Lines 9-12; Benson). Benson relates to

communications apparatuses which obvious to one of ordinary skill in the art could be

defined as a mobile phone a personal digital assistant, a pager, a wireless laptop

computer, a personal computer a television remote control and combinations thereof.

Regarding claim 11, Benson and Chung teach claim 1, wherein said wireless

network is selected from a group consisting of a WWAN, WLAN, private network or

PAN. Benson discloses a wireless link which obvious to one of ordinary skill in the art

could be based on network platform with expected predictable results, therefore as

Benson teaches networks it would be obvious to try any of a WWAN, WLAN, private

network or PAN as an acceptable network.

Regarding claim 12, Benson and Chung teach claim 11, wherein said WWAN is

selected from a group consisting of GSM, CDMA, CDMA 2000 and WCDMA.

Consistent with the above logic if a WWAN were to be implemented the protocol of

networking in said network would be obvious to one of ordinary skill in the art as they

would all provide a predictable outcome and are widely utilized in the art for expected

results.

Regarding claim 13, Benson and Chung teach claim 1, wherein said wireless

mobile device is used for making financial transactions between a user and said entity

and paying for said financial transactions with said smart card over said network

(Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any

well known obvious transaction could be handled by Benson, as the result is predictable

and well known.

Regarding claim 14, Benson and Chung teach claim 13, wherein said financial transactions between said user and said entity are face to face (Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any well known obvious transaction could be handled by Benson, as the result is predictable and well known.

Regarding claim 15, Benson and Chung teach claim 13, wherein said financial transactions between said user and said entity are remote (Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any well known obvious transaction could be handled by Benson, as the result is predictable and well known.

Response to Arguments

5.   Regarding applicant's remarks in response to the Benson reference failing to teach that a smart card may be used for payment, as cited herein above, the Benson reference teaches connection via smartcard with a bank. Therefore the transaction associated, similar to that of an ATM transaction as disclosed by Benson (Column 1, Lines 39-49; Column 4, Lines 57-60; Benson), would be an obvious form of payment for a multitude of reasons obvious to any lay person involved with a bank transaction (applicable ATM fees, a deposited e-check as a 'payment' to a debtor etc.). It is further noted that while the applicant challenges the Benson reference at failing to use the term 'payment' the examiner wishes to draw attention to the fact that the term 'payment' is not explicitly claimed.

Furthermore the rest of the applicant's arguments 'A' through 'C' are rendered moot in view of the new grounds of rejection.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN A. HANNON whose telephone number is (571)272-7385. The examiner can normally be reached on Mon. - Fri. 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. H./
Examiner, Art Unit 2618
April 22, 2008

/Edward Urban/
Supervisory Patent Examiner, Art Unit 2618